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*Karen Cing-Mars 5/26/04*

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In the United States Patent and Trademark Office

OFFICE OF PETITIONS

**Date:** 5/26/04  
**In re Application** Sievers, et al.

**Filed:** 6/22/01

**of:**

**Issued:** 6/4/04

**For:** FOCUSED ION BEAM PROCESS FOR REMOVAL  
OF COPPER

**Serial Number:** 09/887,791

**Patent No:** 6,730,237

**Art Unit:** 1765

**Examiner:** Ahmed, Shamim

**APPLICATION FOR PATENT TERM ADJUSTMENT**

Mail Stop Patent Ext.  
Hon. Commissioner of Patents and Trademarks  
P. O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

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Applicants respectfully submit the present application for patent term adjustment pursuant to 37 C.F.R. §1.705(d) within thirty days of the issue date for the above identified patent.

In compliance with 37 C.F.R. §1.705(b)(1), the fee set forth in 37 C.F.R. §1.18(e) has been authorized for withdrawal from Deposit Account No. 090458.

In compliance with 37 C.F.R. §1.705(b)(1), a statement of facts follows.

The correct patent term adjustment for the above identified patent is 133 days in Applicants' favor. The Determination of Patent Term Adjustment under 35 U.S.C. §1.54(b) accompanying the Notice of Allowance dated November 4, 2003 stated that the

patent term adjustment is 133 days. However, the issued patent states that the patent term adjustment is 13 days. Applicants respectfully request reinstatement of the previous determination of 133 days in Applicants' favor.

Applicants are entitled to 112 of the total 133 days, pursuant to 37 C.F.R.

§1.702(a)(1), because the Patent Office failed to:

Mail at least one of a notification under 35 U.S.C. 132 or a notice of allowance under 35 U.S.C. 151 not later than fourteen months after the date on which the application was filed under 35 U.S.C. 111(a) or fulfilled the requirements of 35 U.S.C. 371 in an international application.

More specifically, the above identified patent was filed on June 22, 2001. The Patent Office mailed a first Office Action on December 12, 2002. The office should have mailed the first Office Action no later than fourteen months after June 22, 2001, or in other words no later than August 22, 2002. 112 days extend between the dates December 12, 2002 and August 22, 2002. Accordingly, pursuant to §1.703(a)(1), Applicants are entitled to an 112 day adjustment in Applicants' favor.

Applicants are entitled to 21 of the total 133 days, pursuant to 37 C.F.R.

§1.702(a)(2), because the Patent Office failed to:

Respond to a reply under 35 U.S.C. 132 or to an appeal taken under 35 U.S.C. 134 not later than four months after the date on which the reply was filed or the appeal was taken.

More specifically, Applicants responded to an Office Action on December 31, 2002. The Patent Office replied on May 21, 2003 with a further Office Action. The Patent Office should have mailed a reply not later than four months after December 31, 2002 or, in other words, no later than April 30, 2003. 21 days extend between the dates May 21,

2003 and April 30, 2003. Accordingly, pursuant to §1.703(a)(2), Applicants are entitled to a 21 day adjustment in Applicants' favor.

In sum, Applicants are entitled to a patent term adjustment of 133 days in Applicants' favor.

Applicants' delay could cause a reduction in the patent term adjustment.

However, Applicants have not delayed conclusion of the prosecution of the above identified patent application. Pursuant to §1.704 (a):

The period of adjustment of the term of a patent under § 1.703(a) through (e) shall be reduced by a period equal to the period of time during which the applicant failed to engage in reasonable efforts to conclude prosecution (processing or examination) of the application.

As stated above, a discrepancy exists between the Determination of Patent Term Adjustment accompanying the Notice of Allowance and the Patent Term Adjustment listed on the face of the issued patent. Accordingly, the Patent Office must have concluded that the Applicants delayed conclusion of the prosecution of the above identified patent application at some point between receipt of the Notice of Allowance and issuance.


The Notice of Allowance was mailed on November 4, 2003. Comments on the Notice of Allowance were mailed on November 13, 2003. The issue fee was paid on January 12, 2004. Because the Patent Office subtracted days from the original 133 day Determination of Patent Term Adjustment, the Patent Office must consider the filing of Comments on the Notice of Allowance as a "period of time during which applicant failed to engage in reasonable efforts to conclude prosecution." Applicants respectfully disagree.

Pursuant to 37 C.F.R. §1.312, any amendment filed after allowance must be filed before or with payment of the Issue Fee. The Notice of Allowance was mailed November 4, 2003. Comments on the Notice of Allowance were filed on November 13, 2004. Applicants paid the Issue Fee on January 12, 2004. Applicants timely filed the Comments of the Notice of Allowance prior to payment of the Issue Fee. Applicants could not have filed the Comments on the Notice of Allowance any sooner than receipt of the Notice of Allowance. In the present case, Applicants filed the Comments within eleven days of receipt of the Notice of Allowance. Certainly, Applicants' action does not constitute a failure to engage in reasonable efforts to conclude prosecution.

The above-identified patent application is not subject to a Terminal Disclaimer.

In conclusion, Applicants are entitled to a patent term adjustment of 133 days because the Patent Office failed to mail a first Office Action within fourteen months of the filing date and further because the Patent Office failed to respond to a reply within four months after the date on which the reply was filed. Applicants filing of a Comments on a Notice of Allowance does not constitute a failure to engage in reasonable efforts to conclude prosecution.

Respectfully Submitted,  
Sievers, et al.

A handwritten signature in cursive script, appearing to read "Lisa J. Ulrich".

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